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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,194	04/06/2004	Bruce B. Bealke	CPSH-003/00US	8837
23419 7590 05/12/2008 COOLEY GODWARD KRONISH LLP ATTN: Patent Group Suite 1100 777 - 6th Street, NW Washington, DC 20001				
EXAMINER RAPILLO, KRISTINE K				
ART UNIT 3626		PAPER NUMBER		
MAIL DATE 05/12/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/820,194

Applicant(s)

BEALKE ET AL.

Examiner

KRISTINE K. RAPILLO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☒ Claim(s) 5, 11 and 15 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claims 1 – 15 are pending.

Claim Objections

1. Claims 5, 11, and 15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may refer in the alternative to only one set of claims. A claim such as "A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8" is improper. 35 U.S.C. 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5, 11, and 15 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12 – 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, independent claim 12 is directed toward both an apparatus and the method steps of using the apparatus, and are therefore considered to be indefinite under 35 U.S.C. 112, second paragraph - see *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). For example, claim 12 contains the following indefinite language: "a method for implementing satisfaction of an insurance claim in which a total dollar amount for the loss is agreed to be paid as satisfaction in full of the claim in return for the execution a release comprising the steps of: ...the system assigning a claim identification number." The applicant discloses in the specification that a system comprises a computerized system which submits claim information over an electronic network (paragraph [0015]), thereby indicating that the system is an

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apparatus. Claims 13 - 15 are replete with the same or similar language and are therefore rejected under the same rationale.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12 – 15 are rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine," but rather overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative form only (see *Id.* at 1551). For example, claim 12 contains the following indefinite language: " a method for implementing satisfaction of an insurance claim in which a total dollar amount for the loss is agreed to be paid as satisfaction in full of the claim in return for the execution a release comprising the steps of:the system assigning a claim identification number." The applicant discloses in the specification that a system comprises a computerized system which submits claim information over an electronic network (paragraph [0015]), thereby indicating that the system is an apparatus. Claims 13 - 15 are replete with the same or similar language and are therefore rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1 – 4 and 6 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gittens et al. (U.S. Publication Number 2002/0077867 A1), herein after Gittens, in view of Horn et al. (U.S. Publication Number 2001/0037204 A1), herein after Horn.

In regard to claim 1, Gittens teaches a method for implementing satisfaction of a settlement of a claim between a claimant and another settling party on agreed to settlement on terms including a monetary amount, comprising:

- a settlement processing entity receiving the settlement terms and their acceptance by the claimant and settling party, including receiving a payment of at least a portion of the monetary amount to be paid to the claimant on behalf of the other party (paragraph [0302]) where the Examiner interprets selection to be a form of acceptance;
- the settlement processing entity initiating the transfer to the claimant of at least one voucher having a stated redemption value and, if required, an electronic transfer of settlement funds in an amount such that the total of the voucher redemption value and funds transferred exceeds said monetary amount (paragraph [0297]); and
- the settlement processing entity paying a vendor obligated to redeem the voucher an amount less than the voucher's stated redemption value for the voucher (paragraph [0313]).

Gittens fails to teach a method comprising a settlement processing entity receiving the settlement terms and their acceptance by the claimant and settling party, including receiving an executed release by claimant of the other settling party.

Horn teaches a method comprising a settlement processing entity receiving the settlement terms and their acceptance by the claimant and settling party, including receiving an executed release by claimant of the other settling party (Figure 41). Horn discloses a method and system of an acceptance of a settlement.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising a settlement processing entity receiving the settlement terms and their acceptance by the claimant and settling party, including receiving an executed release by

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claimant of the other settling party as taught by Horn, within the method of Gittens, with the motivation of facilitating a cost efficient and more timely settlement dispute tool using computerized systems (paragraph [0018]).

In regard to claim 2, Gittens teaches the method of Claim 1 and in which the payment of at least a portion of the monetary amount to be paid to the claimant on behalf of the other party is in an amount which is less than the monetary amount (paragraph [0297]). Gittens discloses an invention in which a voucher is provided for claim settlement.

In regard to claim 3, Gittens teaches the method of Claim 1 and in which the payment of at least a portion of the monetary amount is in an amount which is the monetary amount, and thereafter, a portion thereof is returned to its payor by the settlement processing entity (paragraph [0291]). Gittens describes an invention in which an entity (i.e. claim fulfilling system) negotiates discounted prices for goods and services for which vouchers are used.

In regard to claim 4, Gittens teaches the method of either Claim 2 or Claim 3, and in which the payment is received by the settlement processing entity after the settlement processing entity makes any required electronic transfer of funds to the claimant (paragraph [0261]).

In regard to claim 6, Gittens teaches a method for implementing satisfaction of a settlement of a monetary claim agreed to by a first party and a second party comprising:

- (c) the third party communicating with the first party to provide the first party with the claim identification number and the option to either receive the agreed monetary settlement in full or to receive at least a part of the monetary settlement in the form of vouchers which can be redeemed for goods and/or services (paragraph [0297]);
- (d) the first party electing either to receive the agreed monetary settlement in full or to receive at least a part of the monetary settlement in the form of vouchers and informing the third party of

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the election and if vouchers are elected, the portion of the monetary settlement to be paid in vouchers (paragraph [0297]). Gittens discloses an option of choosing a claim settlement in the form of cash or a voucher, therefore, it would be obvious to have the option of combining the settlement to include a mix of cash and vouchers; and

- (e) the third party withdrawing funds from the funding source and paying the monetary settlement by transmitting vouchers to the first party and/or transferring funds to the first party, in accordance with the election made by the first party, directly to the first party and/or to an account for the benefit of the first party, as directed by the first party (paragraph [0297]).

Gittens fails to teach a method comprising (a) the second party providing a third party with details of the monetary settlement and a source for funding the monetary settlement and (b) the third party assigning a claim settlement identification number to the settlement details.

Horn teaches a method comprising (a) the second party providing a third party with details of the monetary settlement (paragraphs [0084] and [0085]) and a source for funding the monetary settlement and (b) the third party assigning a claim settlement identification number to the settlement details (paragraph [0100] and figures 29 – 31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising (a) the second party providing a third party with details of the monetary settlement and a source for funding the monetary settlement and (b) the third party assigning a claim settlement identification number to the settlement details as taught by Horn, within the method of Gittens, with the motivation of providing a unique identifier to identify the claim for a clear trail of the claim settlement history (paragraph [0021]).

In regard to claim 7, Gittens teaches the method of Claim 6, and in which the third party provides the first party with vouchers which, when combined with the amount, if any, of the funds transferred to the first party from the source of funding, exceed the full amount of the monetary settlement (paragraph [0291]).

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In regard to claim 8, Gittan teaches the method of Claim 7, and in which the funds withdrawn by the third party from the funding source are less than the funds transferred to the first party by an amount agreed upon by the first and second parties as a function of the amount of the vouchers (paragraphs [0261], [0264], and [0265]).

In regard to claim 9, Gittens teaches the method of Claim 7, and in which the third party purchases the vouchers from the suppliers of the goods and/or services at a discount from the face value of the vouchers (paragraphs [0296] and [0313]).

In regard to claim 10, Gittens teaches the method of Claim 8, and in which the third party purchases the vouchers from the suppliers of the goods and/or services at a discount from the face value of the vouchers (paragraphs [0296] and [0313]).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Belben (U.S. Publication Number 2002/0004731 A1) discloses an insurance claim settlement system using a computer system, including financial software applications.
 - Drennen (U.S. Publication Number 2003/0187695 A1) discloses an automated claims settlement acceleration system for the health care industry. The system allows providers to receive reimbursement from an insurer at point of service after claim confirmation.
 - Aquila et al. (U.S. Publication Number 2002/0035488 A1) discloses a system and method of administering, tracking, and managing of claims processing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626